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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,936	12/23/2003	Leslie E. Smith	P-FILM-603	9398
7590	11/16/2004		EXAMINER	
Christopher John Rudy Ste. 8 209 Huron Ave. Port Huron, MI 48060			FONTAINE, MONICA A	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/743,936	SMITH ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Monica A Fontaine	1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 December 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>110404</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-12, drawn to a method for forming wide paint film parts, classified in class 264, subclass 288.4.
- II. Claims 13-15, drawn to an apparatus for forming wide paint film parts, classified in class 425, subclass 383.
- III. Claims 16-19, drawn to an article of manufacture, classified in class 428, subclass 100.11.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus, such as one that is not required to have at least three paint film stock grasping means.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §

806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as extrusion.

Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus, such as an extruder.

During a telephone conversation with Christopher Rudy on 28 October 2004 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 10-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (U.S. Patent 2,759,217), in view of Susa et al. (U.S. Patent 5,760,122). Regarding Claim 10, Peterson shows that it is known to carry out a method for forming

wide film parts (Column 1, lines 15-21), which comprises providing apparatus for forming wide film parts, having a frame; and attached to the frame, at least two film stock grasping members, which generally oppose one another, which can grasp deformable film stock, at least one of which can be moved apart from the other while the stock is grasped (Figure 1); providing a deformable film stock (Column 3, lines 40-44); grasping the stock on generally opposing sides by at least two film stock grasping members (Column 3, lines 44-53); and moving, while the stock is so grasped, the at least one of the two film stock grasping members apart from the other so as to draw or stretch the stock (Column 3, lines 53-74). Peterson does not show stretching a paint film. Susa et al., hereafter "Susa," show that it is known to carry out a stretching operation on a paint film (Column 1, lines 23-30; Column 10, lines 29-39, 61-67). Susa and Peterson are combinable because they are concerned with a similar technical field, namely, processes relating to film parts. It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to use Susa's paint film as the film in Peterson's stretching process in order to obtain a uniformly-stretched paint film part.

Regarding Claim 11, Peterson shows the process as claimed as discussed in the rejection of Claim 10 above, including a process wherein heat is applied to the stock to facilitate stretching (Column 3, lines 67-74), meeting applicant's claim.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson and Susa, further in view of Ghosh (U.S. Patent 6,487,902). Peterson shows the process as claimed as discussed in the rejection of Claim 10 above, but he does not show a specific amount by which the film is stretched. Ghosh shows that it is known to carry out

a stretching operation wherein the stock is stretched to at least about 125% of at least one of its original dimensions before stretching (Figure 11A, 11B, 12A, 12B; Column 12, lines 37-56; It is noted that an extension ratio of 2 is considered as indicating a doubling of dimensions of the film stock.). Ghosh and Peterson are combinable because they are concerned with a similar technical field, namely, stretching processes. It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to carry out Peterson's and Susa's stretching processes until Ghosh's dimensions are reached in order to obtain an article which abides by specific end-use requirements of a certain dimension and stretch ratio.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with regard to stretching operations in general:

U.S. Patent 4,639,033 to Wheatley et al.

U.S. Patent 3,466,706 to Asano

U.S. Patent 3,827,683 to Seborg et al.

U.S. Patent 4,685,230 to Mason, III

U.S. Patent 4,944,668 to Asano et al.

U.S. Patent 5,809,624 to Nakamae et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A Fontaine whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maf  
Maf  
November 4, 2004

  
**MICHAEL P. COLAIANNI**  
**SUPERVISORY PATENT EXAMINER**